

REMARKS

Claims 1-49 are all the claims pending in the application and stand rejected. Applicants thank the Examiner for considering the references cited with the Information Disclosure Statement filed September 29, 2005. Reconsideration and allowance of all the claims are respectfully requested in view of the following remarks.

Claim Rejection – 35 U.S.C. § 112, First Paragraph

The Examiner rejected claim 5 under §112, first paragraph, as failing to comply with the enablement requirement. The Examiner alleges that claim 5 contains subject matter not described in the specification in such a way as to enable one skilled in the art.

Specifically, the Examiner alleges the following is unsupported:

(1) a surrounding key comprising a ring shape larger than said opening that is fixed on an inside surface of said elastic sheet; and

(2) switches that detect the movement in the horizontal direction of said surrounding key;

Applicants request that the Examiner withdraw this rejection in view of the present amendment to claim 5. Furthermore, Applicants submit that the present amendment to claim 5 is supported by at least an exemplary embodiment of this aspect of the present invention shown in FIG. 12 and discussed on page 26, lines 5-30.

Claim Rejections - 35 U.S.C. § 102(b) - Claims 1-4

The Examiner rejected claims 1-4 under § 102(b) as being anticipated by Kobachi et al. (US 2001/0007449). Applicants respectfully traverse this rejection for the reasons set forth below.

Claim 1 recites, *inter alia*, “an elastic sheet having an outside surface disposed on an inside surface of said cabinet” and “a sliding key that is fixed on the outside surface of said elastic sheet.”

The Examiner alleges that the input device of FIG. 27 of Kobachi discloses the above recited features. However, Applicants submit that this combination of features is not disclosed by Kobachi. In particular, as depicted by FIG. 27, the operating portion (portion engaged by finger) is merely connected by edge portion 30 to the edge of elastic structure 2. Furthermore, this edge portion of the elastic structure 2 does not comprise an outside surface of an elastic sheet disposed on an inside surface of a cabinet. Thus, Kobachi does not disclose an operating portion fixed on the outside surface of elastic structure 2.

Thus, Applicants respectfully submit that claim 1 is allowable over the applied reference. Furthermore, Applicants submit that claims 2-4 are allowable, at least because of their dependency.

Claim Rejections – 35 U.S.C. § 103(a)

Claims 1-8, 11-13, 15-17, 21-24, 26-32, 34-39, 43, 44, 46 and 49

The Examiner rejected claims 1-8, 11-13, 15-17, 21-24, 26-32, 34-39, 43, 44, 46 and 49 as being unpatentable over Yasuda (US 5,012,230) in view of Kobachi. Applicants respectfully traverse this rejection for the reasons set forth below.

Applicants submit that the Examiner has failed to establish *prima facie* obviousness, and even if combined as proposed by the Examiner, the applied combination fails to teach or suggest all the features of the claims.

In making the rejection, the Examiner seems to allege that Yasuda teaches most of the features of the claims, but concedes that Yasuda fails to teach or suggest an elastic sheet, the sliding key fixed on the outside surface of the elastic sheet, and sensors detecting the movement in a horizontal direction. To teach these features, the Examiner applies Kobachi alleging that it would have been obvious to one of ordinary skill in the art to implement a function of detecting the horizontal movement of the sliding key in Yasuda and specifying Yasuda's sheet to be an elastic material as taught by Kobachi in order to provide a delicate input control by sensing every movement of the sliding key.

Applicants submit that the Examiner has failed to establish *prima facie* obviousness because teachings of the references themselves are counter to the specific motivation provided by the Examiner. Specifically, the Examiner contends that by modifying Yasuda's sheet to be an elastic material as taught by Kobochi would provide a delicate input control by sensing every

movement of the sliding key. However, Yasuda explicitly teaches away from making the proposed combination.

For example, Yasuda teaches that the friction between the moveable member 22 relative to supporting plate 23 should be minimized:

In order to reduce friction between the mating surfaces 23a and 22d and assure smooth movement of the moveable member 22 relative to the supporting plate 23, a cut-out or recess 22c is formed on the surface 22d to reduce the contact area between the mating surface.

(Yasuda, col. 5, lines 16-20 (emphasis added)). Additionally, as indicated from the passage above, Yasuda teaches of assuring the smooth movement of moveable member 22 relative to supporting plate 23. Therefore, Yasuda explicitly teaches that (1) reduced friction, and (2) smooth relative movement are essential features of the input device.

Despite the above noted teachings of Yasuda, the Examiner alleges that modifying Yasuda with Kobachi's elastic sheet attached to a sliding key will provide a delicate input control by sensing every movement of the sliding key. However, this proposed modification provides: (1) increase friction (infinite friction); and (2) no relative movement. Because the direct impact of the Examiner's propose modifications is counter to the explicit teachings of Yasuda, the Examiner's proposed motivation, teaching or suggestion to combine the references is wholly unsupported. Fixing the movable member 22 to a supporting plate 23 of an elastic material results in absolutely no movement between members 22, 23, when free and smooth movement is directly taught.

Thus, because the Examiner has failed to establish *prima facie* obviousness, Applicants submit that claims 1-8, 11-13, 15-17, 21-24, 26-32, 34-39, 43, 44, 46 and 49 are allowable over the applied combination.

Second, even if combined as attempted by the Examiner, the proposed combination fails to teach or suggest, at least, “a sliding key that is fixed on the outside surface of said elastic sheet,” as recited in independent claims 1, 5, 22 and 30. As conceded by the Examiner on page 5 of the Office Action, Yasuda does not teach the sliding key to be fixed on the outside surface of an elastic sheet. Additionally, Yasuda specifically teaches that the movable member is not fixed to supporting plate 23 (col. 5, lines 16-18). Furthermore, as discussed above under the §102(b) rejection, Kobachi fails to teach or suggest a sliding key that is fixed on the outside surface of an elastic sheet. The operating portion of Kobachi (portion engaged by finger) is merely connected by edge portion 30 to the edge of elastic structure 2. (See FIG. 27). Therefore, even if combined as attempted by the Examiner, the propose combination fails to teach or suggest “a sliding key fixed on the outside surface” of a sheet.

Thus, Applicants submit that independent claims 1, 5, 22 and 30 are allowable, for at least this reason. Furthermore, claims 2-4, 6-8, 11-13, 15-17, 22, 23-24, 26-29, 31-31, 34-39, 43, 44, 46 and 49 are allowable, at least because of their dependency.

Additionally, the Examiner takes “official notice” of the equivalence of the detecting units indicated in claims 11 and 12 for their uses in detection of the movement of objects and the selection of any of these known technologies or devices to detect the movement of the sliding key as being within the level of ordinary skill in the art. (Office Action, page 8)

However, Applicants respectfully submit that the Examiner has failed to provide any evidentiary support for this finding. In order to support an assertion of common knowledge (Official Notice), the Examiner must provide some evidence to support this finding. MPEP § 2144.03 (B) (citing *In re Lee*, 277 F.3d 1338, 1344-45 (Fed. Cir. 2002)). Furthermore, when taking Official Notice, the Examiner must provide some “specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion.” MPEP § 2144.03 (citing *In re Soli*, 317 F.2d 941, 945-46 (CCPA 1963)). Here, the Examiner merely makes a conclusory statement of common knowledge with a general reference to the claims (11 & 12). The Examiner has failed to indicate with specificity what particular portions of the claims comprise the detecting units. Thus, the Examiner has failed to provided the specific factual findings predicated on sound and scientific reasoning as required. Because this assertion of “Official Notice” does not comply with the procedure outlined in the MPEP, Applicants respectfully request that the Examiner withdraw this assertion of Official Notice.

Claim Rejections – 35 U.S.C. § 103 – Claims 9, 10, 40 and 41

The Examiner rejected claims 9, 10, 40 and 41 under § 103(a) as being unpatentable over Yasuda and Kobachi, in further view of Nishino et al. (US 2002/097224; “Nishino”). Applicants respectfully traverse this rejection for the reasons set forth below.

Because Nishino, either alone or in combination with Yasuda and Kobachi, fails to compensate for the above noted deficiencies of the Yasuda/Kobachi combination, Applicants submit that claims 9, 10, 40 and 41 are allowable, at least because of their dependency.

Claim Rejections – 35 U.S.C. § 103(a) – Claims 14, 25 and 33

The Examiner rejected claims 14, 25 and 33 as being unpatentable over Yasuda and Kobachi, in further view of Chuang (US 2003/0080946). Applicants respectfully traverse this rejection for the following reasons.

Because Chuang, either alone or in combination with Yasuda and Kobachi, fails to compensate for the above noted deficiencies of the Yasuda/Kobachi combination, Applicants submit that claims 14, 25 and 33 are allowable, at least because of their dependency.

Claim Rejections – 35 U.S.C. § 103(a) – Claims 18, 19, 20, 42, 45, 47 and 48

The Examiner rejected claims 18, 19, 20, 42, 45 , 47 and 48 as being unpatentable over Yasuda and Kobachi, in further view of Hill et al. (US 2003/0206154; “Hill”). Applicants traverse this rejection as follows.

Because Hill, either alone or in combination with Yasuda and Kobachi, fails to compensate for the above noted deficiencies of the Yasuda/Kobachi combination, Applicants submit that claims 18, 19, 20, 42, 45 , 47 and 48 are allowable, at least because of their dependency.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Amendment Under 37 C.F.R. § 1.116
U.S. Appln No. 10/623,568

Atty. Dkt. No. Q76655

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'David P. Emery', is written over a horizontal line.

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